



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box -1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,511	10/21/2003	Nam-Jeong Lee	1293.1991	8657

21171 7590 07/14/2006

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

NILAND, PATRICK DENNIS

ART UNIT PAPER NUMBER

1714

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/689,511

Applicant(s)

LEE ET AL.

Examiner

Patrick D. Niland

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 9-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/03</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1714

1. Applicant's election with traverse of Group I, claims 1-8 in the reply filed on 4/20/06 is acknowledged. The traversal is on the ground(s) that the restriction is not well founded, the various inventions are so related as to not require separate fields of search, restriction is not mandatory and claims 1-8, 9-19, and 29-41 should be in the same group. This is not found persuasive because the different groups are shown to in fact have different classifications in the restriction requirement of 3/23/06 and to be distinct from each other. The separate classifications and divergent searches resulting therefrom creates an extreme burden on the examiner who is given only 14 hours, by the PTO, to examine the entirety of the invention.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claims 6 and 8 recite "total solid content" and recites a percentage. It is unclear if the percentage is based on weight or volume.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4497932 Trovati.

Trovati discloses an aqueous dispersion of anionic polyurethane which is capable of use as an overcoat at the abstract; column 4, lines 29-46 and 66.

6. Claims 1 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4497932 Trovati.

Trovati discloses an aqueous dispersion of anionic polyurethane which is capable of use as an overcoat at the abstract; column 4, lines 29-46 and 66.

It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the solids content of the instant claim 8 in the composition of Trovati because Trovati states that any dilution can be used at column 4, lines 43-46 and 15% would give about the same properties as 20% of column 4, line 49.

7. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5066713 Flakus.

Flakus discloses a composition which is usable as an overcoat which contains a polyurethane which falls within the scope of the instant claims 1-7. See particularly column 7, lines 31-68 of which the butane diol falls within the scope of the chain extenders of the instant claims 2 and 4. The instant claims are directed to the final overcoating compositions, not the methods of making them. It is not seen that the method of the patentee makes a different polyurethane than the method of the instant claim 2, particularly considering the lack of amounts and other reaction parameters of claim 2. Additional components of the patentee are encompassed by "comprising" of claim 1 and the lack of "closed" language in the instant claims. The final polyurethane of the

Art Unit: 1714

patentee is encompassed by the composition of claim 5 and there is no evidence that the NCO content of the intermediate makes a different product than that of the patentee, whose polyurethanes can mathematically be thought of as divided into individual components possessing the claimed NCO content. The "Darocure" of the examples falls within the scope of the instant claim 7.

8. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5863980 Choi et al..

Choi discloses aqueous dispersions of anionic polyurethanes falling within the scope of the instant claims 1-7 and which are capable of being used as overcoats at the abstract; column 2, lines 1-45, particularly 30-45; column 3, lines 1-67; column 4, lines 1-67; column 5, lines 1-67, particularly 5-67 and especially lines 47-50 which falls within the scope of claim 8; column 6, lines 1-67, particularly 13-19; column 11, lines 56-58; and the remainder of the document.

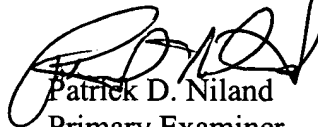
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1714

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick D. Niland
Primary Examiner
Art Unit 1714